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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,601	11/01/2001	Ulrike Rohr	2000DE135	8200

25255 7590 06/02/2003

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/02/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n No.

10/004,601

Applicant(s)

ROHR ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-17.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


CHRISTOPHER RODEE
PRIMARY EXAMINER

110/004,601

Continuation of 2. NOTE: the proposed amendment to claim 1 raises new issues because it specifies performing steps using the mixture of wax coated pigment granules and binder resin and then in the final step "incorporating the mixture into the composition" where the composition is the elected electrophotographic toner or developer. The specification does not disclose incorporating the mixture of binder and granules processed in the proposed manner into a toner or developer (see last Office action). The claim raises new issues for this reason. The amendment to claim 13 raises new issues because the specification only discloses the noted weight percentage of wax coated pigment based on the overall mixture, not just the binder resin (spec. p. 23, bottom). There is no showing why this amendment is now presented as required by Rule 116. Claim 17 is confusing as proposed because the composition is stated as being a binder resin for electrophotographic toner or developer but the claim earlier states that it comprises a binder resin and wax. It is unclear if the composition contains the binder as presented at the end of the claim or the binder resin and wax coated pigment granule as stated at the beginning of claim 17. New claims 18-20 require further search and consideration because these new claims were not previously presented and do not resemble claims previously presented. Additionally, these claims require further search and consideration.

Continuation of 5. does NOT place the application in condition for allowance because: the remarks are directed to the unentered amendments for the section 112 rejections.

Additionally, for the art rejections, the limitations of claim 17 are fully met by the reference because the composition is the intermediate composition for forming the elected toner or developer as noted in the last Office action. The Examiner has shown that this composition contains components that would be recognized as effective for forming a toner, but there is no requirement in this claim that a toner actually be produced. The art need not recognize applicants' intended use for the intermediate composition if the art fully discloses and/or suggests the component of the composition as claimed. Applicants state that the skilled artisan "would find no motivation to employ the wax coated pigment granules of the present invention in an electrophotographic toner or developer" (response p. 10). This is not the invention claimed. The claim states that it is a compound (or composition as proposed) and that the compound (or composition) is a binder for the toner or developer. No toner or developer is present in the claims as presented at Final or as proposed.

With respect to the rejection over claim 1 and those dependent, Diamond does teach that certainty is not present in determining beforehand which compositions will best perform as toners. However, the reference clearly shows the high level of skill in the electrophotographic arts and provides ample guidance to concerns in the art concerning the preparation of toners. The skilled artisan is expected to possess more knowledge than just that specifically stated in the reference. In re Jacoby, 135 USPQ 317. The artisan would have been expected to perform routine optimization of materials and, given the guidance present in the applied art, perform the method discussed in the last Office action. The art teaches an improvement in dispersibility of pigments in binder resins when wax coated. This is a clear and expected benefit and the artisan would combine the references in the manner advanced by the Examiner to obtain the method claimed.

Continuation of 10. Other: The proposed amendment to the specification would be entered if submitted separately. The amendments in claim 17 specifying the pigment as being wax coated would also be entered if submitted separately.

The two references submitted with the after final response have been considered. Applicants are requested to submit a new PTO-1449 with these references listed.